

REMARKS

Claims 1-17 and 19-40 were presented for examination and were rejected. In the present amendment, claims 1, 3, 9, 17, 25 and 32 have been amended and a new claim 41 has been added. No new matter has been introduced. Upon entry of the present amendment, claims 1-17 and 19-41 will be currently pending in this application, of which claims 1, 9, 17, 25 and 32 are independent. Applicants submit that claims 1-17 and 19-41 are in condition for allowance.

The following comments address all stated grounds of rejection. Applicants traverse all rejections and urge the Examiner to pass the claims to allowance in view of the remarks set forth below.

EXAMINER'S INTERVIEW

We thank the Examiner for granting the Examiner's Interview on Monday, April 6, 2009. During the Interview, we discussed the Examiner's response in paragraph 4 of the non-final Office Action dated January 12, 2009.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101**I. Claims 17 and 19-24 Rejected Under 35 U.S.C. § 101**

Claims 17 and 19-24 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner cited paragraph [0093] of the specification and contended that the systems of claims 17 and 19-24 are interpreted as being software only and therefore, non-statutory. Amended claim 17 is independent. Claims 19-24 depend on and incorporate all the patentable subject matter of independent claim 17, as amended. Applicants respectfully submit that claims 17 and 19-24, as amended, are directed to statutory subject matter.

Under the “machine-or-transformation” test of *In Re Bilski* (“Bilski”), claimed subject matter is patentable under 35 U.S.C. §101 if “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” Amended claim 17 recites a system comprising a learning engine configured on a device for storing rejected URLs in a trie structure, and a filter configured on the device for applying the exception rule to a rejected URL. As such, the system is a particular machine and is thus statutory subject matter (see MPEP 2106.01, citing to *In Re Warmerdam*, 33 F.3d 1354, 1360-1361 (Fed. Cir. 1994)).

Because claim 17 is directed to a particular machine, Applicants submit that claim 17 is directed to patent eligible subject matter under 35 U.S.C. §101. Claims 19-24 depend on and incorporate all of the patent eligible subject matter of claim 34, as amended. Thus, Applicants submit that claims 19-24 are also patentable under 35 U.S.C. §101. Accordingly, Applicants request the Examiner to withdraw the rejection of claims 17 and 19-24 under 35 U.S.C. § 101.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

II. Claims 1-17 and 19-40 Rejected Under 35 U.S.C. § 103

Claims 1-17 and 19-40 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,772,347 to Xie et al. (“Xie”) in view of U.S. Patent Publication No. 2005/0086262 to Balasubramanian (“Balasubramanian”) and further in view of U.S. Patent Publication No. 2004/0250124 to Chesla (“Chesla”). Applicants traverse these rejections. Claims 1, 9, 17, 25 and 32 are independent claims. Claims 2-8 depend on and incorporate all the patentable subject matter of independent claim 1, claims 10-16 depend on and incorporate all the patentable subject matter of independent claim 9, claims 19-24 depend on and incorporate all the patentable subject matter of independent claim 17, claims 26-31 depend on and incorporate all the patentable subject matter of independent claim 25, and claims 33-40 depend on and incorporate all the

patentable subject matter of independent claim 32. Applicants submit that Xie, Subramanian and Chesla, alone or in combination, do not teach or suggest each and every feature of the claimed invention.

A. Independent Claims 1, 9, 17, 25 and 32 Patentably Distinguished over Xie in view of Balasubramanian and further in view of Chesla

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Claims 1, 9 and 32 are directed to methods, claim 17 is directed to a system and claim 25 is directed to a computer readable medium. Claims 1, 9, 17, 25 and 32, as amended, recite a rejection rule rejecting messages or URLs based on the messages or URLs comprising the first URL component. These claims also recite generating an exception rule to the rejection rule, the exception rule allowing to pass a message or URL based on the message or URL comprising the first URL component. Xie, Balasubramanian and Chesla, alone or in combination, fail to teach or suggest each and every element of the claimed invention.

The combination of Xie, Balasubramanian and Chesla does not teach or suggest a rejection rule rejecting messages or URLs based on the messages or URLs comprising the first URL component, and generating an exception rule to the rejection rule, the exception rule allowing to pass a message or URL based on the message or URL comprising the first URL component. Xie describes a first set of rules for denying packets and a second set of rules dynamically generated to allow some packets to pass based on additional access control requirements (col. 5, lines 47-52 and col. 6, lines 1-5). Instead of generating an exception rule to a rejection rule based on the same URL component used to reject the messages or URLs, Xie applies a first rejection rule and then generates one or more new rejection rules. Xie generates the additional rules based on additional access control requirements instead of the same attribute

that the first rejection rule is based on. Consequently, these additional rules do not allow to pass a message or URL based on an attribute used by another rejection rule to reject the message or URL. Therefore, Xie fails to contemplate generating an exception rule to a rejection rule based on the same attribute - the first URL component - used to reject a packet. Accordingly, Xie fails to teach or suggest this feature of the claimed invention.

As with Xie, Chesla and Balasubramanian fail to teach or suggest the exception rule to the rejection rule features of the claimed invention. In the Office Action, the Examiner relies only on Xie for suggesting an exception rule feature and cites Chesla and Balasubramanian for different purposes. The Examiner cites Chesla for maintaining a frequency for the number of occurrences with which messages are rejected, and Balasubramanian for a rule-based filtering system where URL requests are filtered at the domain and IP address level to allow/deny traffic for domains beginning with identified IP address information. As such, Chesla and Balasubramanian do not bridge the above identified deficiency in the Xie reference as applied by the Examiner. Therefore, Xie, Chesla and Balasubramanian in combination fail to teach or suggest at least the above exception rule to the rejection rule feature of the claimed invention.

Since Xie, Balasubramanian and Chesla, alone or in combination, fail to teach or suggest each and every feature of the claimed invention, Applicants submit that independent claims 1, 9, 17, 25 and 32 are patentable and in condition for allowance. Claims 2-8 depend on and incorporate all the patentable subject matter of independent claim 1. Claims 10-16 depend on and incorporate all the patentable subject matter of independent claim 9. Claims 19-24 depend on and incorporate all the patentable subject matter of independent claim 17. Claims 26-31 depend on and incorporate all the patentable subject matter of independent claim 25. Claims 33-40 depend on and incorporate all the patentable subject matter of independent claim 32. Thus,

Applicants submit that dependent claims 2-8, 10-16, 19-24, 26-31 and 33-40 are patentable and in condition for allowance. Therefore, Applicants request the Examiner to withdraw the rejection of claims 1-17 and 19-40 under 35 U.S.C. § 103.

PATENTABILITY OF NEW CLAIM 41

III. New Claim 41 Patentable Over Xie, Chesla and Balasubramanian

New claim 41 depends on and incorporates all the patentable subject matter of independent claim 1. Claim 41 recites rejecting the messages based on inclusion of the first URL component in the messages, the first URL component a hierarchical component of a directory path portion of an URL. Applicants submit that claim 41 is patentable and in condition for allowance.

The combination of Xie, Balasubramanian and Chesla does not teach or suggest rejecting the messages based on inclusion of the first URL component in the messages, the first URL component a hierarchical component of a directory path portion of an URL. In the Office Action, the Examiner admits that Xie does not specify filtering based on URLs and URL descendants. Balasubramanian is cited to suggest a filtering system at the domain and IP address level. However, Balasubramanian does not reject the messages based on inclusion of the first URL component. Chesla, on the other hand, fails to even contemplate rejection rules based on URLs, let alone rejection rules based on URL components. Therefore, Xie, Chesla and Balasubramanian, alone or in combination, fail to teach or suggest at least this feature of the claimed invention.

For the reasons discussed above, Applicants submit that Xie, Balasubramanian and Chesla, alone or in combination, fail to teach or suggest each and every feature of the claimed

invention. Accordingly, Applicants submit that claim 41 is patentable and in condition for allowance.

CONCLUSION

In light of the aforementioned amendments and arguments, Applicants contend that each of the Examiners rejections has been adequately addressed and all of the pending claims are in condition for allowance. Accordingly, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of all of the pending claims.

Should the Examiner feel that a telephone conference with Applicants' attorney would expedite prosecution of this application, the Examiner is urged to contact the Applicants' attorney at the telephone number identified below.

Respectfully submitted,

CHOATE, HALL & STEWART, LLP

Dated: April 13, 2009

/Christopher J. McKenna/
Christopher J. McKenna
Registration No. 53,302
Attorney for Applicants

Choate, Hall & Stewart, LLP
Two International Place
Boston, MA 02110
(617) 248-5000